



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,288	12/12/2003	Francois Cottard	LORE:006US	9938

7590 05/03/2006

Mark B. Wilson
Fulbright & Jaworski L.L.P.
Suite 2400
600 Congress Avenue
Austin, TX 78701

EXAMINER

ELHILO, EISA B

ART UNIT	PAPER NUMBER
----------	--------------

1751

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/735,288	Applicant(s) COTTARD ET AL.	
	Examiner Eisa B. Elhilo	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-58, 61-73 and 78-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 98-108 is/are allowed.
- 6) ☒ Claim(s) 54-58, 61, 66-73 and 78-97 is/are rejected.
- 7) ☒ Claim(s) 62-65 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1751

DETAILED ACTION

- 1 This action is responsive to the amendment filed on 2/24/2006.
- 2 The cancellation of claims 1-53 is acknowledged. Pending claims are 54-58, 61-73 and 78-108.

NEW GROUND OF REJECTION

Claim Rejections - 35 USC § 103

- 3 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 54-58, 61, 66-73 and 78-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al. (US 6,461,391 B1) in view of Audousset et al. (US 5,76,903).

Lim et al. (US' 391 B1) teaches a hair dyeing composition comprising an oxidation base of cationic tertiary para-phenylenediamine having a formula (1), which similar to the claimed formula (I), when in the reference formula (1), R, R1 and R2 are alkyl radicals, R4 is hydrogen atom or an alkyl radical and R5 is a hydrogen atom as claimed in claims 54-58 and 61 (see col. 2, formula (1) and lines 44-50) and when in the claimed formula (I), R2 represents the onion radical Z of the claimed formula (II), R3 is a hydrogen atom, n is 1 or 0 and R1 is an alkyl radical. Lim et al. also, teaches the compounds 1-(4-aminophenyl-3-yl) tri-methyl ammonium iodide which is similar to the claimed compounds as claimed in claims 66-70 (see col. 13, Example 16 (compound 1), wherein the composition also comprises para-phenylenediamine derivatives such as 2-[(4-amino-phenyl)-(2-hydroxy-ethyl)-amino]-ethanol (N,N-bis (-hydroxyethyl)-p-

Art Unit: 1751

phenylenediamine) which reads on the claimed formula (V) as claimed in claims 71-72 (see col. 3, lines 60-61), wherein the cationic tertiary para-phenylenediamine is represented in the amount of 0.01 to about 5.0%, which within the claimed range as claimed in claims 73 and 84 (see col. 3, lines 43-46), wherein the composition also comprises oxidation bases such as p-aminophenol that reads of the claimed formula (V'') as claimed in claims 79 and 80 (see col. 4, line 19), 6-hydroxy-indole (1H-indol-6-ol) as claimed in claims 79, 81 and 82 (see col. 7, line 6), cationic polymers as claimed in claim 85 (see col. 9, line 19), thickening polymers as claimed in claim 86 (see col. 8, lines 39-55), surfactants as claimed in claim 87 (see col. 8, lines 23-25), additional primary intermediate (oxidation bases) of benzene-1,4-diamine (para-phenylenediamine) as claimed in claim 88 (see col. 3, lines 56-58), coupler of resorcinol (1,3-dihydroxybenzene) as claimed in claims 90-91 (see col. 4, lines 56-57), wherein the couplers are presented in the amount of 0.005 to 20% which is within the claimed range as claimed in claim 92 (see col. 4, lines 50-52), wherein the primary intermediates (oxidation bases) and the couplers are used in equivalent amounts in the range of 0.00 to about 10 which within the claimed ranges as claimed in claims 83 and 89 (see col. 7, lines 8-15), wherein the composition further comprises direct dyes as claimed in claim 93 (see col. 7, lines 20-54), hydroxylated solvent ethanol as claimed in claim 94 (see col. 8, line 15) and oxidizing agent of hydrogen peroxide as claimed in claim 95 (see 9, line 66). Lim et al. (US' 391 B1) also teaches a method for dyeing hair as claimed in claim 96 (see col. 9, lines 60-64).

The instant claims differ from the reference by reciting benzomorpholine couplers in the claimed composition.

Art Unit: 1751

However, Lim et al. (US' 391 B1) suggests the use of heterocyclic couplers in the dyeing composition (see col. 5, lines 46-64).

Audousset et al. (US' 903) in analogous art of hair dyeing formulation, a composition comprising oxidation bases and couplers such as 6-hydroxybenzomorpholine in the claimed amount as claimed in claims 54 and 78 (see col. 3 formula (IV) and col. 11, Example 3).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the composition of Lim et al. (US' 291 B1) by incorporating the coupler benzomorpholine to make such a composition. Such a modification would be obvious because Lim et al. (US' 391 B1) as a primary reference suggests the use of heterocyclic couplers in the dyeing composition. Audousset et al. (US' 903) as a secondary reference teaches the claimed benzomorpholine coupler in the dyeing formulation, and, thus, a person of the ordinary skill in the art would be motivated to incorporate any heterocyclic coupler includes the claimed species with a reasonable expectation of success for improving the dyeing properties of the composition and would expect such a composition to have similar properties to those claimed in the absent of contrary.

Further, applicant has not shown on record the criticality of the combination of claimed compounds in the composition over the prior art composition.

With respect to claim 97, it would have been obvious to one having ordinary skill in the art at the time the invention was made to formulate such a composition by using a multi compartment device for holding and maintaining the composition because the reference clearly teaches that the oxidation composition is mixed with the oxidizing agent at the time of use (see US' 391, col. 60-64), which implies that both the oxidation composition and the oxidizing agent

Art Unit: 1751

are provided in separate containers, and, thus, a person of the ordinary skill in the art would be motivated to use a multi-compartment devices for holding the dyeing composition, absent unexpected results.

Allowable Subject Matter

4 Claims 62-65 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record do not teach or disclose the limitations of these claims.

5 Claims 98-108 are allowed because the prior art of record do not teach or disclose the limitations of these claims.

Response to Applicant's Arguments

6 Applicant's arguments filed 2/24/2006 have been fully considered but they are not persuasive.

With respect to the rejection based on the combination of Lim et al. (US' 391 B1) with Audousset et al. (US' 903), Applicant argues that Neither Lim nor Audousset teaches that a dyeing composition comprising a cationic tertiary paraphenyldiamine containing a pyrrolidine rings leads to colorations with shades which are not sufficiently intense, not natural and markedly selective as described in the specification.

The examiner respectfully disagrees with the above arguments because the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Art Unit: 1751

Further, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

7 Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

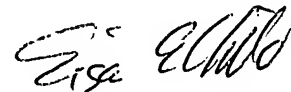
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1751

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eisa Elhilo
Primary Examiner
Art Unit 1751

April 28, 2006